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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,736	12/06/2001	Robert E. Novak	4000.2.96	2664

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EXAMINER	
O'STEEN, DAVID R	

ART UNIT	PAPER NUMBER
2623	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/010,736	NOVAK ET AL.	
	Examiner	Art Unit	
	David R. O'Steen	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 1-11-2005, 8-22-2002, 3-30-2005
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Note to Applicant

1. Art Units 2611, 2614 and 2617 have changed to 2623. Please make all future correspondence indicate the new designation 2623.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5-6, 10, 12, 15, 20, 25-26, 30, 32, 35, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Milewski (US 6,289,346).

As regards Claims 1, 21, and 41, Milewski discloses a method and system for distributing personalized editions of media programs, the method comprising: accessing a media program at an editing device (such as a television with upstream communication, col. 7, lines 7-24); receiving a designation of at least one point of interest within the media program (such as sending to a server, fig. 1.120, a bookmark for the segment of interest, col. 3, lines 10-14 and 31-47), generating a bookmark defining each designated point of interest within the media program (col. 3, lines 37-46), and transmitting the at least one bookmark to a playback device having access to the media program (col. 3, lines 56-63), wherein the at least one bookmark is usable by the

playback device (such as a computer, fig. 1.150) to skip from one point of interest to another within the media program in response to a user command (such as by selecting the URL of one bookmarked segment or going to another, col. 6, lines 18-22, in, for example, an archived news program, col. 5, lines 64-67).

As regards Claims 5 and 25, Milewski further discloses transmitting the at least one bookmark from the editing device to the playback device via a network (such a via server connected to the playback device by the Internet, col. 3, lines 56-63).

As regards Claims 6 and 26, Milewski further discloses that the network is selected from the group consisting of a cable television network, a direct broadcast satellite network, and the Internet (such a via server connected to the playback device by the Internet, col. 3, lines 56-63).

As regards Claims 10 and 30, Milewski further discloses that the at least one bookmark is encapsulated within a program interface object (in this case, in HTML format with the bookmark location information stored as a URL and with ass associated descriptive text explaining the bookmark, col. 7, lines 33-41).

As regards Claim 12 and 32, Milewski further discloses that at least one bookmark comprises a non-time positional reference (such as at the beginning of a news segment, col. 5, lines 64-67).

As regards Claims 15 and 35, Milewski further discloses that accessing comprises downloading the media program from a server (such as an archive server, fig. 1.125, and col.6, lines 19-23).

As regards Claim 20 and 40, Milewski further discloses that the editing device comprises an interactive television system (such as accommodating upstream communication, col. 7, lines 7-24).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 4, 11, 16-19, 22, 24, 31, and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski (US 6,289,346) in view of Vallone (US 6,642,939).

As regards Claims 2 and 22, Milewski discloses the method and system of Claim 1 and 21 as well as accessing the program at the playback device (such as the PC, fig. 1.150) from a source other than the editing device (such as the archives server, fig. 1.125); and receiving at least one bookmark at the playback device (col. 3, lines 56-63) but fails to disclose that during the presentation of the media program, skipping to a point of interest marked by at least one bookmark in response to a user command. Vallone discloses that during the presentation of the media program, skipping to a point of interest marked by at least one bookmark in response to a user command (col. 21, lines 11-18).

At the time of invention, it would have been obvious for one skilled in the art to combine the skipping during a media presentation, as in Vallone, an analogous art, with the book-marking method of Milewski to further increase the ease of navigation through the media for the user.

As regards Claims 4 and 24, Vallone further discloses starting a presentation of the media program at a position marked by a previous bookmark in response to a user command received at the playback device (the user can continue watching a program at a bookmark left to signify where the user stopped watching a particular program, col. 16, lines 40-42 or, indeed, watch a program starting at a place marked by any of his bookmarks, col. 16, lines 49-50).

As regards Claims 11 and 31, Vallone discloses that at least one bookmark comprises a time reference (col.16, lines 40-42).

As regards Claims 16 and 36, Vallone further discloses that accessing comprises digitally recording the media program from a broadcast medium (cols. 20 and 21, lines 34-38 and 11-18).

At the time of invention if would have been obvious to one skilled in the art to combine the digital recording of Vallone, an analogous art, with the book marking of Milewski because digital recording is prevalent and easy for a viewer to use.

As regards Claims 17 and 37, Vallone further discloses that accessing comprises accessing a removable storage medium (mediums which can hold media with bookmarks that the user can assess includes DVDs, VCRs, and MP3s) including the media program (col. 21, 19-22).

At the time of invention if would have been obvious to one skilled in the art to combine the removable storage mediums of Vallone, an analogous art, with the book marking of Milewski because storage mediums like DVDs are prevalent and easy for a viewer to use.

As regards Claim 18 and 38, Vallone further discloses that the removable storage medium comprises a digital versatile disk (DVDs) (col. 21, lines 19-22).

As regards Claims 19 and 39, Vallone further discloses that the playback device comprises an interactive television system (such as a system that allows easy interactivity such as digital recording and "trick play" as well EPG functions, figs. 17-19 and col. 20, lines 33-38).

Claims 3, 13, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski (US 6,289,346) in view of Abecassis (US 5,610,653).

As regards Claim 3, Milewski discloses the method and system of Claim 1 but fails to disclose starting the presentation of the media program at a position defined by a next bookmark. Abecassis discloses starting the presentation of the media program at a position defined by a next bookmark (col. 40, lines 31-38).

At the time of the invention it would have been obvious to one skilled in the art to combine the jumping to the next bookmark as done in Abecassis, an analogous art, with the method of Milewski so that viewers could skip over objectionable material.

As regards Claims 13 and 33, Abecassis further discloses that at least one bookmark marks a beginning of a segment of interest (by flagging off a segment and including it, col. 40, lines 31-38).

Claims 7 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski (US 6,289,346) in view of Voyticky (US 6,438,751).

As regards Claims 7 and 27, Milewski discloses the method and system of Claims 1 and 21, but fails to disclose transmitting the at least one bookmark from the editing device to the playback device using a wireless technique. Voyticky discloses transmitting the at least one bookmark from the editing device to the playback device using a wireless technique (col. 5, lines 34-46).

At the time of invention, it would have been obvious to one skilled in the art to combine the wireless technique of Voyticky with the book-marking method of Milewski because using a wireless transmission method makes sending bookmarks easy for the user.

Claims 8-9 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski (US 6,289,346) in view of Hatano (US 6,951,031).

As regards Claims 8 and 28, Milewski discloses the method and system of Claims 1 and 21 but fails to disclose physically transporting the at least one bookmark from the editing device to the playback device on a removable storage medium. Hatano discloses physically transporting the at least one bookmark (such as a URL) from the

editing device to the playback device on a removable storage medium (such as a DVD, col. 11, lines 4-12). The examiner notes that once bookmarked information is on a removable storage medium such as a DVD, one is able to transfer it to other devices such as a playback device.

At the time of invention, it would have been obvious to one of ordinary skilled in the art to combine the physical transportation of Hatano with the book-marking method of Milewski to make transporting bookmarks easier for the user.

As regards Claims 9 and 29, Hatano further discloses that the storage medium is selected from a group consisting of a magnetic disk, an optical disc (such as a DVD, col. 11, lines 4-12), and a non-volatile flash memory card.

Claims 14 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski (US 6,289,346) in view of Abecassis (US 5,610,563) and in further view of Novak (US 4,750,213)

As regards Claims 14 and 34, Milewski discloses the method and system of Claims 1 and 21 but fails to disclose the at least one excerpt comprises at least one bookmark marks an end point of a segment comprising at least one advertisement within the media program. Abecassis discloses that a bookmark marks an end point of a segment comprising at least one segment within the media program (col. 40, lines 31-38).

At the time of invention it would have been obvious to a person of ordinary skill in the art to combine the segment book-marking of Abecassis, an analogous art, with the

book-marking of Milewski to allow the user to quickly and easily identify segments of media.

Milewski and Abecassis, however, both fail to disclose that the segment comprises at least one advertisement within the media program. Novak discloses that the segment comprises at least one advertisement within the media program. (cols. 1 and 3, lines 23-31 and 12-55).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to identify advertisements as done in Novak, an analogous art, in the method of Milewski to allow the user to skip advertisements or commercials that do not interest him.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski (US 6,289,346) in view of Vallone (US 6,642,939) and in further view of Abecassis (US 5,610,653).

As regards Claim 23, Milewski and Vallone jointly discloses the system of Claim 22 but fails to disclose that the playback control component starts presentation of the media program at a position marked by a next bookmark in response to a user command received by the playback device. Abecassis discloses that the playback control component starts presentation of the media program at a position marked by a next bookmark in response to a user command received by the playback device (col. 40, lines 31-38).

At the time of the invention it would have been obvious to one skilled in the art to combine the jumping to the next bookmark as done in Abecassis, an analogous art, with the method of Milewski so that viewers could skip over objectionable material.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David R. O'Steen whose telephone number is 571-272-7931. The examiner can normally be reached on 8:30 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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